

VIA FACSIMILE ONLY

Patent
Attorney Docket No. 4389

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPEAL NO. 2009-5706**

Appellant:	Brian E. Dalton)	
)	
Application No.:	10/642,976)	Swiger III, James L.
)	Patent Examiner
Filed:	August 18, 2003)	Art Unit 3733
)	
For:	CERVICAL COMPRESSION PLATE ASSEMBLY)	
)	Pittsburgh, Pennsylvania

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

Applicant received a Docketing Notice from the Board of Patent Appeals and Interferences mailed March 20, 2009. A copy of the Docketing Notice is enclosed.

The Docking Notice indicates that no reply to the Brief was filed. However, this is not the case.

Applicant filed a REPLY TO EXAMINER'S ANSWER on June 17, 2008, the same has been considered by the Examiner and was forwarded to the Board. A copy of the REPLY TO EXAMINER'S ANSWER and the Examiner's Notice is attached.

Accordingly, kindly also consider Applicant's REPLY TO EXAMINER'S ANSWER.

Respectfully submitted,

CAROTHERS AND CAROTHERS



Floyd B. Carothers
Attorney for Brian E. Dalton
Fort Pitt Commons, Suite 200
445 Fort Pitt Boulevard
Pittsburgh, PA 15219

FBC:jkc
Reg. No. 24,252
(412) 471-3575
(412) 471-3597 Fax
Pittpatent@aol.com



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,976	08/18/2003	Brian E. Dalton	4389	3409
7590	03/20/2009			
Floyd B. Carothers CAROTHERS AND CAROTHERS Suite 200 445 Fort Pitt Blvd. Pittsburgh, PA 15219				EXAMINER
				SWIGER III, JAMES L
			ART UNIT	PAPER NUMBER
			3775	
			MAIL DATE	DELIVERY MODE
			03/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Page 1

**United States Patent and Trademark Office**

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

FLOYD B. CAROTHERS
CAROTHERS AND CAROTHERS
SUITE 200
445 FORT PITT BLVD.
PITTSBURGH, PA 15219

Appeal No: 2009-5706
Application: 10/642,976
Appellant: Brian E. Dalton

**Board of Patent Appeals and Interferences
Docketing Notice**

Application 10/642,976 was received from the Technology Center at the Board on December 16, 2008 and has been assigned Appeal No: 2009-5706.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: January 28, 2008
Reply Brief filed on: NONE
Request for Hearing filed on: NONE

In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

**BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450**

The facsimile number of the Board is 571-273-0052. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 571-272-9797 and should be directed to a Program and Resource Administrator.

By order of the Board of Patent Appeals and Interferences



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,976	08/18/2003	Brian E. Dalton	4389	3409
7590	07/34/2008		EXAMINER	
CAROTHERS AND CAROTHERS			SWIGER III, JAMES L	
Suite 500			ART UNIT	PAPER NUMBER
445 Fort Pitt Blvd.			3733	
Pittsburgh, PA 15219				
			MAIL DATE	DELIVERY MODE
			07/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10642976	8/18/2003	DALTON, BRIAN E.	4389

CAROTHERS AND CAROTHERS
Suite 500
445 Fort Pitt Blvd.
Pittsburgh, PA 15219

EXAMINER

JAMES L. SWIGER III

ART UNIT PAPER

3733 20080721

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The REPLY TO EXAMINER'S ANSWER filed on 6/17/2008 has been considered and is being forwarded to the Board of Patent Appeals and Interferences.

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733

/JAMES L SWIGER/
Examiner, Art Unit 3733

Patent
Attorney Docket No. 4389

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant:	Brian E. Dalton))
Application No.:	10/642,976)	Swiger III, James L.
Filed:	August 18, 2003)	Patent Examiner
For:	CERVICAL COMPRESSION PLATE ASSEMBLY)	Art Unit 3733
			Pittsburgh, Pennsylvania

REPLY TO EXAMINER'S ANSWER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's Answer requires a response in regard to the Examiner's arguments set forth under Section (10) Response to Argument. Appellant therefore replies as follows:

(10) RESPONSE TO ARGUMENT

The Examiner states that "The functional limitation of being 'configured to' is similar to 'capable of' where it has been held at the recitation that an element is 'capable of' performing a function is not a possible limitation but only requires the ability to so perform and further does not constitute a limitation in any patentable sense." In this regard the Examiner cites *In re Hutchison*, 69 USPQ 138.

This analysis made by the Examiner is completely inaccurate. The limitation "configured to" specifically means that the device so configured must have the required dimensions and contours to carry out the required function. To the contrary, the term "capable of" implies no such physical limitations and therefore the Examiner's analysis does not follow. The term "configured to" cannot be considered equal to the term "capable of". It is respectfully submitted that while the term "capable of" is not a positive limitation, that nevertheless, the term "configured to" is in fact a positive limitation. Therefore, the ruling of *In re Hutchison* does not apply.

In conclusion, the references or any combination thereof do not suggest Applicant's invention as claimed, and the Examiner's rejection should be overturned.

Respectfully submitted,

CAROTHERS AND CAROTHERS

Floyd B. Carothers
Attorney for Brian E. Dalton
Fort Pitt Commons, Suite 200
445 Fort Pitt Boulevard
Pittsburgh, PA 15219

FBC:jkc
Reg. No. 24,252
(412) 471-3575
(412) 471-3597 Fax
Pittpatent@aol.com

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 12, 2009

CAROTHERS AND CAROTHERS

Jean K. Carothers

Carothers and Carothers

Fort Pitt Commons, Suite 200
445 Fort Pitt Boulevard
Pittsburgh, PA 15219

Business Phone: 412-471-3575
Fax: 412-471-3597
Email Address: Pittpatent@aol.com

FAX COVER SHEET

DATE:	April 10, 2009
TO:	Board of Patent Appeals and Interferences
FAX PHONE:	(571) 273-0052
FROM:	Floyd B. Carothers
SUBJECT:	Appeal No. 2009-5706
PAGES:	9 (including cover sheet)

DOCUMENT	NUMBER OF PAGES

COMMENTS:

***** CONFIDENTIALITY NOTICE *****

The documents accompanying this telecopy transmission contain confidential information belonging to the sender which is legally privileged. The information is intended only for the use of the individual or entity named above. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this telecopied information is strictly prohibited. If you have received this telecopy in error, please immediately notify us by telephone to arrange return of the original documents.